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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/621.631	03/26/96	BROWN	F 621.631

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EXAMINER
MILLER, E

ART UNIT	PAPER NUMBER
3641	

DATE MAILED: 03/30/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/621,631

Applicant(s)

Brown et al.

Examiner

Mok

Group Art Unit

3641

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 2-8-99
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-20 is/are pending in the application.
- Of the above claim(s) 2-98 11-20 is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 1810 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

1. The request filed on February 8, 1999 for a Continued Prosecution Application (CPA) under 37 C.F.R. 1.53(d) based on parent Application Serial No. 08/621,631 is acceptable and a CPA has been established. Action on the CPA follows.
2. The text of those sections of Title 35, U. S. Code, not included herein can be found in a prior Office action.
3. The single ultimate species remains the same as set forth in Paper No. 13.
4. Claims 1 and 10 are rejected under 35 U.S.C. 102 (b or e) as anticipated by or, in the alternative, under 35 U.S.C. 103 as obvious over each of the Harbuck et al. article and Carlson '970.

In Carlson '970, note "Example E", col. 15-16, where scandium is recovered by extraction with DEHPA and then stripped with 2M NaOH, the scandium extraction being quantitative. This is from the earlier process of "Example B", col. 10, which may be from a sulfuric/boric acid leach, line 42, or via sulfuric acid alone, line 52. In Harbuck et al., pages 109-110, strong sulfuric acid worked well, as did extraction with DEHPA at pages 114-115, e.g., and stripping with NaOH on page 116, e.g. This is as the claims are understood. To the extent necessary, variation of parameters would have been obvious to one of ordinary skill in the art. It is well settled that optimizing a result effective variable is well within the expected ability of a person of ordinary skill in the subject art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955).

5. Claims 1 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what the starting material is. In claim 1, line 5, "the fluorine reduced material" has no antecedent basis, and it is not clear that fluorine reduces (the valence of?) the material, e.g. In the last line of claim 1, it is not clear what selectively extracting a metal value requires. Likewise in the last line of claim 10, it is not clear what a scandium metal value means. One would ordinarily recite scandium values, generic to dissolved scandium without regard to anion(s). These are exemplary.

6. All claims are drawn to the same invention claimed in the parent application prior to the filing of this CPA application under 37 C.F.R. 1.53(d) and could have been finally rejected on the grounds of record in the next Office action.

Accordingly, **THIS ACTION IS MADE FINAL**, even though it is a first action after

the filing under 37 C.F.R. 1.53(d). Applicant is reminded of the extension of time policy under 37 C.F.R. 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

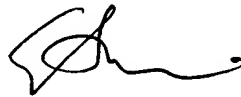
7. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163.

Examiner Miller may normally be reached daily, except alternate Fridays, from 8:30 AM to 6 PM.

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor, Mr. Jordan, can be reached at (703) 306-4159. The Group fax number is (703) 305-7687.

If there is no answer, or for any inquiry of a general nature or relating to the application status, please call the Group receptionist at (703) 308-1113.

Miller/em
March 29, 1999



EDWARD A. MILLER
PRIMARY EXAMINER